

**IN THE U.S. PATENT AND TRADEMARK OFFICE**

In re application of

Sumit ROY et al.

Conf. 6741

Application No. 10/522,815

Group 3731

Filed October 21, 2005

Examiner Kathleen C Sonnett

METHOD AND DEVICE FOR INTERCONNECTION OF TWO TUBULAR ORGANS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

May 12, 2009

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

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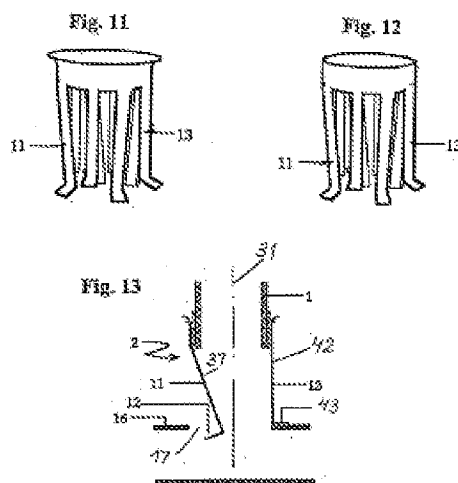
## **REASONS IN SUPPORT OF REQUEST FOR REVIEW**

Claims 20-30 and 33-35 are pending in the application. Claims 20-30 and 33-35 have been rejected. Claims 20 and 35 are independent claims.

Claims 20-30, 34 and 34 have been rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. Claims 20-25, 30 and 33-35 have been rejected under 35 USC §102(b) as being anticipated by BLOOMER (U.S. Patent 2,537,183). Claims 26, 27, 28 and 29 have been rejected under 35 USC §103(a) as being unpatentable over BLOOMER respectively in view of HART (U.S. Patent 1,339,620 - claim 26), DEFAUW (U.S. Patent 3,358,357 - claim 27), HAURY (U.S. Patent 2,211,776 - claim 28) and FROST (U.S. Patent 3,228,713 - claim 29). Withdrawal of these rejections as being clearly deficient is respectfully requested.

At paragraph 2 the Official Action asserts *"Applicant claims that the fingers are of uniform radial thickness. However, there is no disclosure in the specification or figures to support a limitation of fingers made of material with a uniform thickness."*

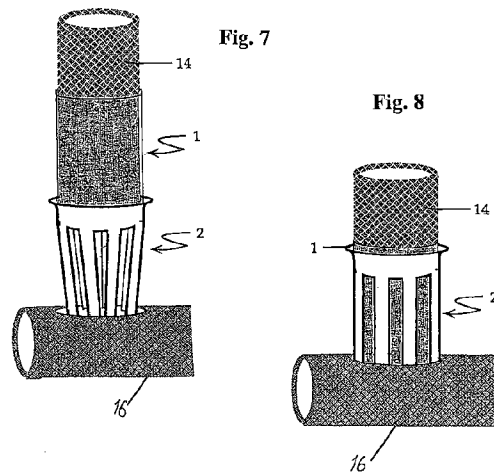
As can be seen, the application's drawing figures clearly show a uniform thickness of the main portion 11 and the gripping portion 12, as is shown by way of example, in Figures 11-13, which are reproduced below.



The Official Action itself concedes: *"Although the cross section shows the finger is relatively the same thickness where the cross-section was taken, this doesn't mean that each of the fingers could not be thicker at locations circumferentially offset of the place where the cross section was taken."* Indeed, care was taken to ensure that in every drawing figure showing the fingers in cross-section, their thickness was uniform.

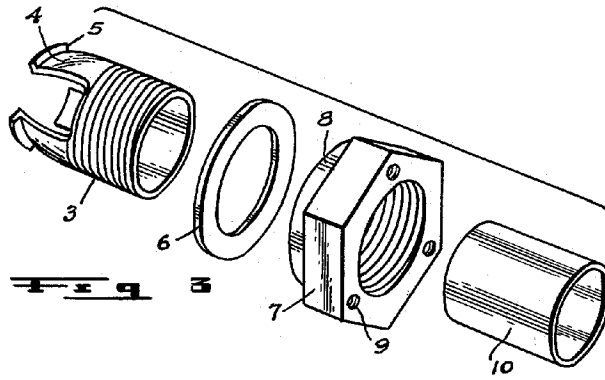
Nonetheless, even if *arguendo* there could be other thicknesses (as asserted in the Official Action), the applicant is still entitled to claim uniform thicknesses since United States case law points out the specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). The test is whether the disclosure reasonably conveys to one of ordinary skill that applicant had possession of the claimed subject matter. *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). As a result, the claims are in full compliance with the written description requirement.

The present invention pertains to a connecting device having a first element 1 and a second element 2 that is shown, by way of example, in Figures 7 and 8 of the application, reproduced below.



The second element is provided with at least two elongated first fingers of uniform radial thickness arranged at intervals along the circumference of the first passage. Each of the fingers is formed from a main portion extending from a second front portion, and the main portion is continuous with a gripping part directed away from a longitudinal axis in an undeformed condition of the second element, and introduction of the first element into the second element displaces the main portions of the fingers radially outwards. See claim 20.

In contrast, BLOOMER pertains to a coupling connection having a third element, including a **threaded** tubing having one end formed with an inwardly curving reduced internal diameter. See claim 1 and Figure 3 of BLOOMER, reproduced below.



BLOOMER includes a third element, a nut 7, receivable on the threads of the first element (see, e.g., claim 1, column 3, line 48). In contrast, the present invention includes only two elements as clearly stated in claim 20. That is, the present invention has a second element that does not incorporate threads. The device of claim 20 of the present invention is composed of only two elements.

Also, even "if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference." That there is no ambiguity in this interpretation of 35 USC § 102 has been confirmed in *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Additionally, omission of an element and retention of its function is an indicia of patentability. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966). On the other hand, the case law cited in the Official Action in this context (*Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004), *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) is not germane to the issue, because it is the prior art (BLOOMER) that includes additional elements and not the applicant's invention.

That is, BLOOMER unambiguously states that the first element 10 is threaded (see, e.g., claim 1, column 3, line 43). In contrast, in the present invention, the corresponding structure, the second element 2, does not incorporate threads. The purported equivalence between structure 10 of BLOOMER and structure 2 of the present invention does not hold up, because "the accused device must contain at least an equivalent for each limitation" (*Pennwalt Corp v Durand-Wayland Inc*, 833 F2d 931 (Fed. Cir. 1987)). Further as was clarified in *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958), "equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure."

BLOOMER thus fails to anticipate claim 20 of the present invention. The other applied art references do not address the deficiencies of BLOOMER discussed above. Therefore, claims depending upon claim 20 are patentable for at least the above reasons.

The above-described failures by the Examiner thus constitute clear error, and withdrawal of the rejections as being clearly deficient is accordingly respectfully solicited.